

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte JAMES R. JOHNSON

**MAILED**

Appeal No. 2001-1763  
Application 08/899,434

**FEB 26 2003**

ON BRIEF

PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Before GARRIS, WALTZ, and LIEBERMAN, Administrative Patent Judges.

WALTZ, Administrative Patent Judge.

**DECISION ON APPEAL**

This is a decision on an appeal from the primary examiner's final rejection of claims 1 through 3, 8 and 12.<sup>1</sup> Claims 9 through 11 and 13 through 15, the only other claims pending in this application, stand allowed by the examiner (Brief, page 3;

<sup>1</sup> Appellant's amendment subsequent to the final rejection, amending claim 15, has been entered by the examiner and obviates the final rejection of claims 1-3 and 8-15 under 35 U.S.C. § 112, ¶2 (see the amendment dated Sep. 7, 2000, Paper No. 16, entered as per the Advisory Action dated Sep. 22, 2000, Paper No. 18).

Advisory Action dated Sep. 22, 2000, Paper No. 18). We have jurisdiction pursuant to 35 U.S.C. § 134.

According to appellant, the invention is directed to an apparatus for dispensing, applying and sealing individual sections of thermoplastic tape having one or more fastener profiles thereto (Brief, page 4). Appellant states that the claims stand or fall together for each ground of rejection (Brief, page 6). A copy of illustrative independent claim 1 is attached as an Appendix to this decision.

The examiner relies upon the following references as evidence of obviousness:

Martin	3,659,767	May 02, 1972
Schroth et al. (Schroth)	4,608,115	Aug. 26, 1986
Kanemitsu et al. (Kanemitsu)	5,400,568	Mar. 28, 1995
Kühnhold et al. (Kühnhold)	5,413,656	May 09, 1995
Rajala	5,659,229	Aug. 19, 1997
Bodolay et al. (Bodolay) (filed Nov. 6, 1995)	5,776,045	Jul. 07, 1998

Claims 1 and 8 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Bodolay in view of Kanemitsu and Schroth (Answer, page 2). Claim 2 stands rejected under 35 U.S.C. § 103(a) as unpatentable over the references as applied against claims 1 and 8, further in view of Rajala (Answer, page 4). Claim 3 stands rejected under 35 U.S.C. § 103(a) as unpatentable over the references applied against claims 1 and 8, further in

view of Martin (*id.*). Claim 12 stands rejected under 35 U.S.C. § 103(a) as unpatentable over the references applied against claims 1 and 8, further in view of Kühnhold (Answer, page 5).

We affirm all of the rejections on appeal essentially for the reasons stated in the Answer and those set forth below.

#### **OPINION**

The examiner presents findings of fact and conclusions of law regarding Bodolay, Kanemitsu and Schroth, on pages 2-4 of the Answer. The examiner makes additional findings and conclusions with regard to the secondary references to Rajala, Martin, and Kühnhold, on pages 4-6 of the Answer. Appellant's sole argument is that the claims relate to maintaining the tension of the tape during sealing, and this "claimed tensioning is non-obvious over all the cited references" (Brief, page 6).

This argument is not persuasive. As correctly argued by the examiner, appellant is arguing a limitation which is not claimed (Answer, page 6). The only recitation of "tension" in the claims is the "means for delivering tensioned tape and fastener profile from said tape dispensing means" (see claim 1; Answer, page 6). However, this recitation refers to the tape before cutting (i.e., before the tape advances to the tape cutter assembly; see claim 1

and page 6 of the Answer). There is no language in claim 1 on appeal of a relationship between the cut tape and the tape sealing mechanism, and therefore we cannot agree with appellant that the claims require that the tension of the tape is maintained during sealing. See *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997) (the PTO must apply to the verbiage of the claims the broadest reasonable meaning of the words in their ordinary usage, as understood by one of ordinary skill in the art and defined by the specification). However, it is incorrect to read unwritten limitations into pending claims contrary to the plain words of those claims. See *In re Zletz*, 893 F.2d 319, 322, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). See also *In re Prater*, 415 F.2d 1393, 1405, 162 USPQ 541, 551 (CCPA 1969) (During pendency of an application, limitations are not to be read from the specification into the claims).

For the foregoing reasons and those set forth in the Answer, we determine that the examiner has established a *prima facie* case of obviousness in view of the reference evidence. Based on the totality of the record, including due consideration of appellant's argument, we determine that the preponderance of evidence weighs most heavily in favor of obviousness within the

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meaning of section 103. Accordingly, we affirm all of the examiner's rejections on appeal.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

**AFFIRMED**

Broaden R. Merrill

BRADLEY R. GARRIS  
Administrative Patent Judge

*Thomas A. Waltz*  
THOMAS A. WALTZ  
Administrative Patent Judge

THOMAS A. WALTZ  
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*Paul Lieberman*  
PAUL LIEBERMAN  
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APPENDIX

1. An apparatus for dispensing, applying, and sealing individual sections of thermoplastic tape having one or more fastener profiles thereto, said tape being sealed across a portion of a web of thermoplastic material, said apparatus comprising: means for dispensing said tape and fastener profile; a tape applicator apparatus; means for delivering tensioned tape and fastener profile from said tape dispensing means, said means for delivering comprising a tape registration assembly for adjusting the position of said tape and fastener profile and a tape drive assembly for advancing said tape and fastener profile; a tape cutter assembly for cutting said tape and fastener profile into individual sections of a preselected length; vacuum belt means for advancing said section of tape and fastener profile into a position across said web of thermoplastic material; a tape sealing mechanism for applying pressure and heat to said tape section on said web for a specified dwell time; and means for sequentially advancing said web.